



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,399	07/01/2003	Kohichi Katoh	239700US2	9354

22850 7590 07/27/2006

C. IRVIN MCCLELLAND  
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

DOTE, JANIS L

ART UNIT PAPER NUMBER

1756

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/609,399

Applicant(s)

KATOH ET AL.

Examiner

Janis L. Dote

Art Unit

1756

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 10 July 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 7 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 10 July 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-6 and 18-20.  
Claim(s) withdrawn from consideration: 8-12.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 4/12/06  
13. ☐ Other: \_\_\_\_\_

*Janis L. Dote*  
JANIS L. DOTE  
PRIMARY EXAMINER  
GROUP 1756  
1700

Continuation of 3. NOTE: The proposed amendments to claims 1 and 6 filed after the final rejection on Jul. 10, 2006, adding the limitation that the toner composition is mixed using a "TURBULA SHAKER MIXER T2F-10B-50A . . . (mixer)," raises new issues because said limitation was not present in the claims when the final rejection was mailed on Feb. 09, 2006. The proposed amendments to claims 1 and 6 also raise a rejection under 35 U.S.C. 112, second paragraph, for the reasons discussed in the office action mailed on Sep. 15, 2005, paragraph 7.

Continuation of 11. The examiner's refusal to enter the amendment filed after the final rejection on Jul. 10, 2006, renders applicants' arguments regarding said amendment moot. Applicants' assertions that the "state of the external additive present on the surface of the toner of the present invention is different from the states of the external additives in Totsuka et al. and in JP'054" are mere attorney arguments that are not supported by any objective evidence. The claim language "external additive located on the surface of the toner particles and comprising Si" recited in instant claims 1 and 6 does not exclude the Totsuka alumina particles surface-treated with dimethylsilicone and a fluoro-silicone-containing compound. Nor does the claim language exclude the negatively charged silica particles disclosed by JP'054. Moreover, the examiner is merely using the available evidence of record to determine whether or not it is reasonable to transfer the burden to applicants to distinguish over prior art processes. Those prior art processes are deemed to be the ones that meet all of the express structural and compositional limitations in the claims, and that disclose properties that are consistent with the properties taught by applicants as advantages due to satisfying the relationship recited in instant claims 1, 2, and 6. Patents are not properly issued for the discovery of a new property of an old composition. In addition, applicants' assertions that the recitations in instant claims 4, 5, and 18-20 are not statements of intended use, but are functional limitations, are not persuasive. The "charge quantity" of the replenished toner composition when "the replenished toner composition and the previously existing toner composition [in the mixing section] reach the regulating member" appears to depend on how the replenishing toner and the existing toner are used or manipulated in the developing device, not on the toner composition recited in the instant claims.

Applicants submit that the List of Related Cases in the Information Disclosure statement filed on Sep. 23, 2004, was "submitted in a proper manner, since Mr. Nicholas Godici, former Commissioner for Patents, stated on August 4, 2004 that copies of cited pending applications are no longer required. Applicants have satisfied their duty of disclosure by providing this listing to the Examiner. The OG Notice of October 19, 2004 . . . does not state that its effects are not retroactive."

Applicants are mistaken. The notice states "[t]his waiver is effective immediately." (i.e., Oct. 19, 2004.) No private communication could possibly put the policy into effect prior to publication of the notice.